

## REMARKS

### I. STATUS OF THE CLAIMS

Claims 1-12 and 26-37 were pending in this application. Claims 1, 5, and 27 have been amended. Following entry of the amendments claims 1-12 and 26-37 will be pending and at issue.

### II. SUPPORT FOR AMENDMENTS TO THE CLAIMS

Claims 1, 5, and 27 were amended as shown above. Support can be found throughout the application as filed, e.g., claim 1 as filed and Example 1 at paragraphs 59-62 of the specification as filed.

The amendments to the claims therefore add no new matter and entry is respectfully requested.

### III. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 27 was rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Without agreeing with the Examiner, but merely to further prosecution, Applicant has amended claim 27 as shown above. Withdrawal of this rejection is requested.

### IV. REJECTIONS UNDER 35 U.S.C. § 103

**Claims 1-5, 11, 32, and 34-37** were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087). Applicant traverses this ground of rejection by argument.

The cited prior art does not teach all of the elements of the claims.

The Examiner stated that “Polansky fails to teach partially melting an inner wall of a test tube and coating the inner wall of the test tube with a plurality of beads and coating the beads with a capture reagent.” Office Action at 3.

The Examiner then stated that “Glad teaches a substrate having a capture reagent coated with a defined quantity of beads, wherein the beads are coated with a capture reagent of the macromolecules of interest (col. 3, lines 3-53).” Office Action at 3-4. Glad does not remedy the deficiencies of Polansky. As admitted by the Examiner, Glad merely teaches “beads [] with a capture reagent,” but does not teach a method step of “coating the beads with a capture reagent,” as required by claim 1. *Id.* In addition, Glad does not teach partially melting an inner wall of a test tube or coating the partially melted inner wall of the test tube with a plurality of beads. *See* claim 1.

The Examiner then stated that “Wolfbeis et al. teach partially melting a substrate to immobilize beads permanently within the layer (col. 5, lines 44-56 and col. 6, lines 56-60), in order to provide a rough and reactive sensor surface.” Office Action at 4. Wolfbeis does not remedy the deficiencies of Polansky and Glad. Wolfbeis merely teaches coating a piece of glass with a powder or gel and then sintering it for 40 minutes in a muffle furnace at 720-800°C. Wolfbeis at col. 6, lines 46-60. Thus, Wolfbeis does not teach partially melting an inner wall of a test tube and coating the partially melted inner wall of the test tube with a plurality of beads. Instead, Wolfbeis teaches performing these method steps in the reverse order, i.e., coating with particles and then heating.

As a result the combination of the cited art would yield a method distinct from the claimed method. *See* claim 1. Using the cited art, one of skill would have taken the tube of Polansky, filled it with the pre-coated beads of Glad, and then heated the tube using the method of Wolfbeis. Therefore, the combination of the cited art does not teach each and every element of the claimed invention.

Thus, the combination of cited art cannot render the claims obvious. A *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 6** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et

al. (US 4,965,087), as applied to claim 1, and further in view of Orth et al. (US 2003/0153010).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 7** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, and further in view of Stimpson et al. (US 5,599,668).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claims 8 and 9** were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Zhang (US 2003/0046717).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of

cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 10** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Liu et al. (US 2004/0014101).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 12** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of LaMotte (US 5,296,347).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 26** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Schall et al. (US 6,699,677).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of

cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 27** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Hendriks (US 4,251,616).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claims 28-30** were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Leach et al. (US 5,470,609).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 31** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Sivaraja (US 6,569,619).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art

fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

**Claim 33** was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Polansky (US 2003/0068616) in view of Glad (US 6,156,550) further in view of Wolfbeis et al. (US 4,965,087), as applied to claim 1, further in view of Neumann et al. (US 4,366,242).

For the reasons cited above, Polansky, Glad, and Wolfbeis fail to teach each and every element of the claimed invention and their combination by one of ordinary skill in the art would have yielded a method distinct from the claimed invention. The additional cited art fails to remedy the deficiencies of Polansky, Glad, and Wolfbeis. Thus, the combination of cited art cannot render the claims obvious. Therefore, a *prima facie* case of obviousness is not made. Withdrawal of this ground of rejection is respectfully requested.

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PATENT

### CONCLUSION

In view of the foregoing, the application is now in condition for allowance. The prompt issuance of a formal Notice of Allowance is therefore requested. If the examiner believes that a personal communication will expedite further prosecution of this application, the examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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